

REMARKS

Amendments

Composition claims 1-5 are converted to method claims for the preparation of a fuel cell member. New claim 6 is an independent claim corresponding to the combined recitations of claims 1, 3, and 4. New claim 7 is directed to a fuel cell member made by the claimed method. New claim 22 is directed method of reducing the amount of ions eluting from the materials used to make a fuel cell. See, e.g., page 3, lines 5-19.

New claims 8-21 are directed to further aspects of the invention and are supported throughout the disclosure. See, e.g., page 5, lines 10-12, page 6, lines 11-13, page 7, lines 1-3, page 7, lines 15-18, page 7, line 25 – page 8, line 2, page 9, lines 12-14, and the original claims.

Information Disclosure Statement

The instant application is the US National Phase application of International Application PCT/JP2004/011825. The Information Disclosure Statement filed February 17, 2006 merely the references cited in the International Search Report issued in International Application PCT/JP2004/011825. The Office Action presents no rationale as to why the references cited by the International Search Authority would be ignored.

In any event, applicants submit herewith a further Information Disclosure Statement with copies of the references cited in the International Search Report.

Rejection under 35 USC 102(e) in view of Tomomatsu et al. (US 2004/0048967)

Claims 1-5 are rejected as allegedly being anticipated in view of Tomomatsu et al. (US 2004/0048967). This rejection is respectfully traversed.

In the rejection, it is asserted that “fuel cell member” did not limit the claimed composition. The original claims are now rewritten as method claims, specifically methods for preparing a fuel cell member comprising molding a resin composition to form the fuel cell member. It is respectfully submitted that the recitation of “fuel cell member” in the method claims must be given weight.

Tomomatsu et al. disclose a process for making a thermoplastic resin composition

and/or a rubber composition by kneading extruding the thermoplastic resin composition and/or a rubber composition with a compressed filler using a specific kneading extruder. See, e.g., paragraph [0018].

The rejection specifically refers to paragraph [0097] of Tomomatsu et al. This paragraph relates to the preparation of a thermoplastic resin composition in accordance with Tomomatsu et al.'s invention (i.e., Example 1) and three Comparative Examples. Example 1 and the three Comparative Examples all contain 73% polypropylene, 4% ethylene-octene 1 copolymer, and 23% talc. In Example 1 and Comparative Example 2, the talc is compressed to have a bulk specific gravity of 0.70. In Comparative Examples 1 and 3, the talc is not compressed.

The disclosure of paragraph [0097] of Tomomatsu et al. provides no suggestion of a method for manufacturing a fuel cell member. Nor does it provide any suggestion of a fuel cell member manufactured from a certain resin composition. Additionally, paragraph [0097] of Tomomatsu et al. provides no suggestion of method of reducing the amount of ions eluting from the materials used to make a fuel cell. In fact, the entire disclosure of Tomomatsu et al. is devoid of any suggestion of fuel cells, fuel cell members, and/or the materials and methods used to manufacture fuel cell members.

To establish anticipation, the rejection must indicate where the asserted anticipatory reference discloses each feature of the rejected claim. See, e.g., *Ex parte Levy*, 17 USPQ2d 1461, 1462 (POBA 1990) [“Moreover, it is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference.”]. The rejection fails to indicate where Tomomatsu et al. have any disclosure relating to fuel cells, let alone disclose the fuel cell aspects recited in applicants' claims.

In view of the above remarks, it is respectfully submitted that Tomomatsu et al. (US 2004/0048967) fails to anticipate applicants' claimed invention. Withdrawal of the rejection is respectfully requested.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

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Date: July 2, 2008